

REMARKS

Applicant has received and carefully reviewed the Office Action mailed on November 27, 2007, prior to preparing this response. Currently, claims 11-21 are pending in the application, wherein claims 11-21 have been rejected. Claims 11 and 15 have been amended with this paper. No new matter has been added. Favorable consideration of the following remarks is respectfully requested.

Claims 11-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Preissman et al., U.S. Patent No. 5,728,063. Applicant respectfully traverses the rejection.

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” M.P.E.P. §2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In formulating the rejection, the Examiner apparently is asserting that Preissman et al. do not teach each and every claimed limitation of claims 11-17, but instead appears to be relying on supposed “common knowledge” in an attempt to establish a *prima facie* case of obviousness.

The Manual of Patent Examining Procedure expressly states that “[i]t is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.” M.P.E.P. §2144.03, citing *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Such “common knowledge” or “common sense” must be “capable of such instant and unquestionable demonstration as to defy dispute.” M.P.E.P. §2144.03, quoting *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). Applicant respectfully traverses the official notice taken in the Office Action.

As disclosed in Preissman et al., the catheter body includes an inner tubular member, a soft outer layer, and a braided reinforcement layer located between the inner tubular member and the soft outer layer. See Preissman et al., at column 7, lines 1-60. At no point do Preissman et al. suggest that the braided reinforcement layer be adhered to either the inner tubular member or the soft outer layer or that the braided reinforcement layer be formed of a polymeric material which adheres to both the inner tubular member and the soft outer layer. Instead, the braided reinforcement layer is braided “over the inner tubular member using conventional braiding techniques.” Preissman et al., at column 7, lines 15-18. The braided reinforcement layer is held in contact with the inner tubular member by forming the soft outer layer over the braided

reinforcement layer. Applicant respectfully requests that if the rejection is to be maintained, documentary evidence must be provided in the next Office Action in support of the conclusory assertions made in the Office Action. See M.P.E.P. §2144.03.

Turning to the claims, claim 11 recites that the inner layer and outer layer are secured together with a polymeric mediator layer adhered to both the inner layer and the outer layer. Claim 16 recites that the catheter tube includes a mediator layer providing adhesive anchorage between the inner layer and the outer layer. In formulating the rejection, the reinforcement layer 112 or 114 of Preissman et al. is equated to the claimed “mediator layer.” As discussed above, Preissman et al. do not teach that the reinforcement layer 112 or 114 is adhered to either the inner tubular member 108 or the soft outer layer 110 or provides adhesive anchorage between the inner tubular member 108 and the soft outer layer 110. The reinforcement layer 112 or 114 is held in contact with the inner tubular member 108 by forming the soft outer layer 110 over the braided reinforcement layer. Thus, the reinforcement layer 112 or 114 does not contribute to securing the inner tubular member 108 to the soft outer layer 110 to help prevent de-lamination of the soft outer layer 110 from the inner tubular member 108. The reinforcement layer 112 or 114 is present simply to provide greater stiffness and column strength to portions of the catheter body. See Preissman et al., at column 10, lines 44-49.

For at least the reasons stated above, claims 11 and 16 are believed patentable over the cited reference, as a *prima facie* case of obviousness has not been established regarding either claim 11 or claim 16. Claims 12-15 and 17, which depend from one of claim 11 and 16 and include additional limitations, are also believed patentable over Preissman et al. Withdrawal of the rejection is respectfully requested.

Claims 18-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Preissman et al., U.S. Patent No. 5,728,063, in view of Gold et al., U.S. Patent No. 4,636,346. Applicant respectfully traverses the rejection.

Claim 18 recites a middle layer disposed between the outermost layer and the innermost layer and affixing the outermost layer to the innermost layer. Similarly, claim 20 recites a middle layer disposed between the outermost layer and the innermost layer and affixing the outermost layer to the innermost layer. In formulating the rejection, the reinforcement layer 112 or 114 of Preissman et al. is equated to the claimed “middle layer.” As discussed above, Preissman et al. do not teach that the reinforcement layer 112 or 114 affixes the soft outer layer

110 to the inner tubular member 108. The reinforcement layer 112 or 114 is held in contact with the inner tubular member 108 by forming the soft outer layer 110 over the braided reinforcement layer. Thus, the reinforcement layer 112 or 114 does not contribute to affixing the inner tubular member 108 to the soft outer layer 110 to help prevent de-lamination of the soft outer layer 110 from the inner tubular member 108. The reinforcement layer 112 or 114 is present simply to provide greater stiffness and column strength to portions of the catheter body. See Preissman et al., at column 10, lines 44-49.

Gold, which the Examiner relies on as teaching a tube comprising an outermost layer having a high coefficient of friction and an innermost layer having a low coefficient of friction, fails to remedy the shortcomings of Preissman et al. Namely, the teachings of Gold would not apprise one of skill in the art to the notion that the reinforcement layer 112 or 114 affixes the soft outer layer 110 to the inner tubular member 108.

For at least the reasons stated above, claims 18 and 20 are believed patentable over the cited references, as a *prima facie* case of obviousness has not been established regarding either claim 18 or claim 20. Claims 19 and 21, which depend from one of claim 18 and 20 and include additional limitations, are also believed patentable over the cited references. Withdrawal of the rejection is respectfully requested.

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By his Attorney,

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